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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,764	11/21/2003	Kenneth B. Wagener	5853-340	1454

30448 7590 08/08/2006

AKERMAN SENTERFITT
P.O. BOX 3188
WEST PALM BEACH, FL 33402-3188

EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/718,764

Applicant(s)

WAGENER ET AL.

Examiner

Kuo-Liang Peng

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1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/13/06 RCE.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,8 and 13-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 and 13-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-36 is/are rejected.
- 7) ☐ Claim(s) 35-36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 13, 2006 has been entered. Claims 1-6 and 9-12 are deleted. Claims 7-8 and 13-31 are withdrawn. Claims 33-36 are amended. Now, Claims 32-36 are pending for consideration.

2. Claim objection(s) in the previous Office Action (Paper No. 020406) is/are removed.

3. Claim rejection(s) under 35 USC 112, second paragraph, in the previous Office Action (Paper No. 020406) is/are removed.

4. In view of Applicants' amendment, claim rejection(s) under 35 USC 102(b) in paragraphs 11 and 12 of the previous Office Action (Paper No. 020406) is/are moot.

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None of Yajima600 (US 4 220 600) and Yoshitake (US 6 184 407) teaches or fairly suggests a latent group-containing poly(silakylene-siloxane) with ethylenically unsaturations in the polymer backbone set forth in the claimed invention.

5. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

Claim Rejections - 35 USC § 112

6. Rejection of Claims 32-36 under 35 USC 112, first paragraph is maintained because the rejection is adequately set forth in paragraph 9 of Paper No. 020406. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants argument (Remarks, page 9, 1st to 3rd paragraph), it appears that the **specific** structures of the instant claims are not supported by the specification.

Claim Rejections - 35 USC § 102

7. Claims 32-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Brezezinska (Journal of Polymer Science, Part A: Polymer Chemistry, vol. 38 (2000), 1544-1550).

Brezezinska discloses a poly(carbosilane-co-carbosiloxane) by copolymerizing the corresponding carbosilane and carbosiloxane precursors, which has a latent methoxy group. Note that compound 5 should possess alkenyl groups at the chain ends because of the acyclic diene metathesis method used for preparing the copolymer, which are crosslinkable groups. Furthermore, the methoxy groups can be at the chain ends, which can be considered as crosslinkable groups too. (Figure 2) Furthermore, a copolymer having chlorine latent reactive group can also be prepared by using similar technique. (page 1549, right column, last paragraph)

For Applicant's argument (Remarks, page 11, 4th paragraph), Applicants argue that Brezeinska does not teach or disclose alkenyl groups at the chain ends. However, the instant claims do not claim alkenyl groups at the chain ends. Furthermore, Brezeinska's compound 5 should possess alkenyl groups at the chain ends because of the acyclic diene metathesis method used for preparing the copolymer. In addition, "s" in the instant claims can be 0. Therefore, the polymers in the instant claims do not

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necessarily possess methoxy groups at the chain ends. Finally, it appears that the polymers in the instant claims do not necessarily contain chlorine latent reactive groups.

8. Claim 36 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action.

Brezeinska does not teach or fairly suggest the polymer containing polyoxyethylene segments set forth in the instant claim.

9. Claim 35 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Brezeinska does not teach or fairly suggest the polymer containing trimethoxysilyl groups at the chain ends set forth in the instant claim.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp
July 28, 2006


Kuo-Liang Peng
Primary Examiner
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